

## REMARKS/ARGUMENTS

Claims 1-33 are pending in this application. Claims 1-8, 10-24, and 28-33 were rejected.

In the Office Action, the Examiner objects to claims 9 and 25-27 as dependent upon a rejected base claim, but indicated that they would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Claim 9 has been rewritten in independent form, including all the limitations of the base claim. Claims 25-27 are amended to depend on claim 9. Therefore claims 9 and 25-27 are all in condition for allowance.

Claims 1-3, 8, 10-12, 15, 18, 20-22, 29, 31 and 32 were rejected by the Examiner under 35 U.S.C. §102(e) as being anticipated by U.S. Patent Application Publication No. 2005/0161644 to Zhang et al. (hereinafter "Zhang"). This rejection is improper for the following reasons.

All of the independent claims require, "the fluid volume has a molar concentration of hydroxyl ions more than about  $10^{-7}$  mole per liter". In item 1(d) of the Office Action, the Examiner cites paragraph [0006] of Zhang as teaching one of ordinary skill in the art to create a fluid volume between about  $10^{-7}$  and  $10^{-1}$  moles per liter of hydroxyl ions. Applicant respectfully disagrees. Paragraph [0006] of Zhang has a "laundry list" of additives which can be included in an immersion fluid from anywhere from 10 ppm to the maximum solubility limit. Nowhere in paragraph [0006] is the concentration of hydroxyl ions that a particular additive will give mentioned. Further, the solubility of a given compound depends upon the temperature of the solution, which cannot be ascertained from the Zhang reference cited. Thus, there is no basis for assuming that Zhang's fluid is at a temperature in which the solubility limit of a given one of the compounds listed is at least  $10^{-7}$  moles per liter of hydroxyl ions. Solutions as taught by Zhang do not necessarily have at least  $10^{-7}$  moles per liter of hydroxyl ions. Thus, Zhang cannot inherently disclose the claimed subject matter.

**M.P.E.P. § 2112** recites:

"To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized

by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.' " *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999) (emphasis in original)

Because Zhang does not indicate temperature, Applicant's claimed concentration is not necessarily present, and is not inherent in Zhang. Thus, Zhang does not expressly or inherently teach every element of Applicant's claims. For a reference to anticipate a claim, that reference must expressly or inherently teach every element of that claim.

Further, paragraph [0006] of Zhang would not have enabled one of ordinary skill in the art to practice the invention of claims 1-3, 8, 10-12, 15, 18, 20-22, 29, 31 and 32, as one of ordinary skill in the art could not use the teachings of paragraph [0006] to make a solution with a desired hydroxyl ion concentration falling within the claimed range. The Examiner has cited no authority indicating how one of skill in the art would fill in this gap. Withdrawal of this rejection is respectfully requested.

In Items 3 through 6 of the Office Action, the Examiner rejects claims 4, 5, 13-17, 22, 23, 30, and 33 under 35 U.S.C. § 103(a) as being unpatentable over Zhang; rejects claims 6 and 18 under 35 U.S.C. § 103(a) as being unpatentable over Zhang in view of U.S. Patent Application Publication No. 2005/0133688 to Li et al. (hereinafter "Li"); and rejects claims 7 and 19 under 35 U.S.C. § 103(a) as being unpatentable over Zhang in view of U.S. Patent Application Publication No. 2003/0215616 to Pierrat (hereinafter "Pierrat"). Because Zhang neither discloses nor suggests the claimed hydroxyl ion concentration, and because Zhang is non-enabling, these rejections are improper. Applicant respectfully requests that Examiner withdraw the rejections.

In view of the foregoing amendments and remarks, Applicant submits that this application is in condition for allowance. Early notification to that effect is respectfully requested.

The Assistant Commissioner for Patents is hereby authorized to charge any additional fees or credit any excess payment that may be associated with this communication to deposit account **04-1679**.

Respectfully submitted,

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